

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

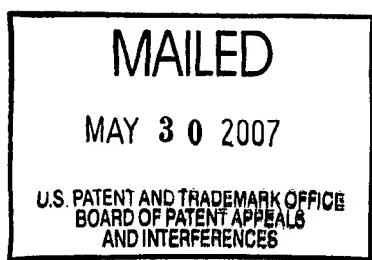
Ex parte MICHAEL A. VYVODA,
N. JOHAN KNALL
and
JAMES M. CLEEVES

Application 09/918,853

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on March 13, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on December 15, 2005.



37 CFR § 41.37(c)(1) (2005) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on page 7 of the Appeal Brief filed December 15, 2005 is deficient because it does not map the independent claims to the specification. See § 1205.03(B) of the Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Rev. 3, August 2005) which states:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37 (c)(1)(v), an entire new brief need not, and

should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

Correction is required.

In addition, § 1207.02 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 3, August 2005) states in part:

Requirements for Examiner's Answer

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

It is noted that while the Examiner's Answer mailed February 13, 2006, states that “[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal” [page 3 under the caption “Evidence Relied Upon”], the claim rejections are listed as follows:

Claims 113-117, 119, 122-124, 126, 128, 130-132, 134-136, 137-140, 142-145 and 147-153 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas, Michael (U.S. patent 6,509,283 B1) [page 3];

Claims 118, 121, 125 and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas as applied to claims 113-117, 119, 122-124, 126, 128, 130-132, 134-136, 137-140, 142-145 and 147-153 above, and further in view of Kwan et al. (U.S. patent 6,335,288 B1) [page 8];

Claim 120 is rejected under 35 U.S.C. 103 as being unpatentable over Thomas as applied to claims 113-117, 119, 122-124, 126, 128, 130-132, 134-136, 137-140, 142-145 and 147-153 above, and further in view of Denison et al. (U.S. patent 5,869,149) [page 10];

Claims 127 and 141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas as applied to claims 113-117, 119, 122-124, 126, 128, 130-132, 134-136, 137-140, 142-145 and 147-153 above, and further in view of Cleeves et al. (U.S. patent 6,541,312 B2) [pages 10 and 11];

Claim 146 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas as applied to claims 113-117, 119, 122-124, 126, 128, 130-132, 134-136, 137-140, 142-145 and 147-153 above, and further in view of Kawakami et al. (U.S. patent 6,399,520 B1) [page 11];

Claim 133 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas as applied to claims 113-117, 119, 122-124, 126, 128, 130-132, 134-136, 137-140, 142-145 and 147-153 above [page 12];

Claims 1-5, 7, 10-12, 14, 16, 18-20, 22-24, 35, 38-40, 55-58, 60-63 and 65-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Moon et al. (US 2002/0137266 A1) [page 12];

Claims 6, 9, 13, 17 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Moon

as applied to claims 1-5, 7, 10-12, 14, 16, 18-20, 22-24, 35, 38-40, 55-58, 60-63 and 65-71 above, and further in view of Kwan [page 20];

Claims 8 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Moon as applied to claims 1-5, 7, 10-12, 14, 16, 18-20, 22, 23, 24, 35, 38-40, 55-58, 60-63 and 65-71 above, and further in view of Denison et al. [page 22];

Claims 15 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Moon as applied to claims 1-5, 7, 10-12, 14, 16, 18-20, 22, 23, 24, 35, 38-40, 55-58, 60-63 and 65-71 above, and further in view of Cleeves et al. [page 23];

Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Moon as applied to claims 1-5, 7, 10-12, 14, 16, 18-20, 22, 23, 24, 35, 38-40, 55-58, 60-63 and 65-71 above, and further in view of Kawakami et al. [page 24];

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Moon as applied to claims 1-5, 7, 10-12, 14, 16, 18-20, 22, 23, 24, 35, 38-40, 55-58, 60-63 and 65-71 above [page 24];

Claims 72-76, 78, 81-83, 85, 87, 89-91, 93-99, 101-104 and 106-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Chung et al. (U.S. patent 5,930,650) [page 25];

Claims 77, 80, 84 and 88 [are] rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Chung as applied to claims 72-76, 78, 81-83, 85, 87, 89-91, 93-99, 101-104 and 106-112 above, and further in view of Kwan [page 31];

Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Chung as applied to claims 72-76, 78, 81-83, 85, 87, 89-91, 93-99, 101-104 and 106-112 above, and further in view of Denison et al. [page 33];

Claims 86 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas as applied to claims 72-76, 78, 81-83, 85, 87, 89-91, 93-99, 101-104 and 106-112 above, and further in view of Cleeves et al. [page 34];

Claim 105 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Chung as applied to claims 72-76, 78, 81-83, 85, 87, 89-91, 93-99, 101-104 and 106-112 above, and further in view of Kawakami et al. [page 34]; and

Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Chung as applied to claims 72-76, 78, 81-83, 85, 87, 89-91, 93-99, 101-104 and 106-112 above [page 35].

Correction is required.

Before further review, the examiner must mail a PTOL-90 that will include in the amended Evidence Relied Upon section, the list of references mentioned in the Grounds of Rejections. See the Manual of Patent Examining Procedure, (MPEP) § 1207.02. Appropriate correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellants to submit a paper providing a revised "Summary of Claimed Subject Matter";
- 2) for consideration of said paper;
- 3) issue and mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer;; and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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